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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,265	08/18/2003	James Edward Angelo	50103-566	1518

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SEAGATE TECHNOLOGY LLC  
c/o MCDERMOTT WILL & EMERY LLP  
600 13TH STREET, NW  
WASHINGTON, DC 20005-3096

EXAMINER

FALASCO, LOUIS V

ART UNIT PAPER NUMBER

1773

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/642,265

Applicant(s)

ANGELO ET AL.

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/12/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### PAPERS RECEIVED

Applicants' Information Disclosure Statement filed 8/18/03 is acknowledged, but will not be considered in this action.

### CLAIMS

The claims are 11 to 20.

### RESTRICTION OF INVENTION

#### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 11-18, drawn to a recording medium, classified in class 428, subclass 848.8.
  - II. Claims 19 and 20, drawn to a stamper, classified in class 425, subclass 110.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of

the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product such as a retro-reflective sheeting, or holographic and liquid-crystal displays.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, and because the inventions require a different field of search, a search in 428/303 required for Group II, is not required for Group I and a search in 425/848.1 required for Group I, is not required for Group II (see MPEP § 808.02) placing a burden on examination, restriction for examination purposes as indicated is proper.

#### *Election of Species*

If Group I is elected:

The following patentably distinct species with non-coextensive search areas must also be elected from Group I:

- A. *Annular shaped zones* with search in class 369, subclass 111 included in claim 12.
  - B. *Rectangular embossments* with search in class 369, subclass 124.08 included in claim 13.
  - C. *Sinusoidal embossments* with search in class 369, subclass 99 included in claim 14.
  - D. Metal magnetic media substrates comprised of **Al**, **Al based alloy** or **Al/NiP** with search in class 428, subclass 846.7 included in claim 15.
  - E. Organic compound magnetic media substrates comprised of **polymer** with search in class 428, subclass 847 included in claim 15.
  - F. Magnetic media substrates comprised of **glass**, **glass-ceramic** or **ceramic** and **glass**, **glass-ceramic** or **ceramic** substrates with *sol-gel* coating with search in class 428, subclass 846.9 included in claims 15 and 16.
  - G. Servo pattern substrates with search in class 369, subclass 278 included in claim 17.
  - H. Magnetic media laminates in the data zone of a magnetic medium with search in class 360, subclass 94 included in claim 18.
4. Applicants are required under 35 U.S.C. 121 to elect a single species for prosecution on the merits. Currently claim 11 is generic. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species

which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added, applicant must indicate which are readable upon the elected species. *MPEP* § 809.02(a).

5. Applicants are advised that a reply to this requirement must include an identification of the species and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. A telephone call was made to John Hankins on July 18, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### INQUIRY

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1285. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LF  
07/06

  
CAROL CHANEY  
SUPERVISORY PATENT EXAMINER